REMARKS

Claims 9 - 25, directed to non-elected inventions, have been canceled without prejudice to their presentation in one or more divisional applications. Previous amendments to the specification, found objectionable as introducing new matter, have been deleted, and the remaining claims have been amended by deleting certain previous amendments thereto, in order to overcome the rejection under 35 U.S.C. §112, first paragraph. In addition, independent claims 1 and 26 have been further amended by adding recitals that the toners are produced by a method that was originally defined in now-canceled claim 22. Since this Amendment does not increase either the total number of claims or the number of independent claims, no additional fee is necessary.

Claims 1 (independent; amended), 2 - 8 (dependent on 1), 26 (independent; amended), and 27 - 33 (dependent on 26) are in the application. No claim has been allowed.

Without conceding that the amendments previously made in the specification constituted new matter, but to expedite prosecution, applicants have canceled all amendatory matter from the specification (including the Abstract) by replacing all previously amended paragraphs with new paragraphs identical to those set forth in the specification as originally filed. It is submitted that these amendments fully overcome the new matter objection to the specification.

Similarly, applicants have amended independent claims 1 and 26 to delete the amendatory language, previously presented, that was based on the specification amendments now canceled. It will be noted that, unlike the specification amendments, these claim amendments do not restore to the claims the erroneous recitals, originally set forth, of "the toner particles having an average circularity of 0.93 to 0.97."

Applicants believe that the deletion of the previously added language self-evidently overcomes the rejection of the claims under §112, first paragraph, as failing to comply with the written description requirement.

With reference to the rejection of the claims on the cited art, it may initially be noted that each of the two independent claims (1 and 26) has been amended to define further the recited toner by setting forth that

> "said toner is produced by mixing a fluidity-imparting agent with a classified toner preparation material, using a rotary agitator blade mixer equipped with a rotary agitator blade, under the conditions which satisfy a formula:
>
> $$50 \leq (V \bullet T)/M \leq 200$$
>
> wherein V is a peripheral speed (m/sec) of said rotary agitator blade of said rotary agitator blade mixer, T is a stirring and mixing time (sec), and M is a weight (kg) of said toner to be stirred and mixed."

This recital was originally contained in method claim 22 (now canceled as non-elected) and is also supported by the disclosure in the original specification, e.g. in the paragraph bridging pp. 11-12, and at p. 20, line 3, to p. 22, line 19, noting also Example 1 (see p. 56) and Comparative Examples 1 and 2 (see pp. 67-70).

As there explained,

> "In the case . . . where $(V \bullet T)/M > 200$, the circularity of the toner particles thereof is non-uniform, and when the toner is sieved using a 500-mesh sieve, there is found a great difference in

> level between the circularity of the residual toner which remains on the meshes of the sieve and the circularity of the toner which passes through the meshes of the sieve, with the residual toner which remains on the meshes of the sieve having much higher circularity than that of the toner which passes through the meshes of the sieve" (p. 21, lines 1-13).
>
> "In the case of $(V \bullet T)/M < 50$, that is, in the case where the stress applied to the toner is insufficient when the fluidity-imparting agent is mixed in the rotary agitator blade mixer, the fluidity-imparting agent is not uniformly mixed with the classified toner preparation material, so that the toner with the desired fluidity cannot be obtained. Furthermore, when this toner is sieved with the 500-mesh sieve, coarse particles of the fluidity-imparting agent and finely divided toner particles without the deposition of the fluidity-imparting agent thereon are apt to remain in the toner, causing the image defects such as the non-image transferred spots in the form of the glow of fireflies in the dark and/or in the form of worm-eaten spots" (p. 22, lines 6-19).

In contrast, when $50 \leq (V \bullet T)/M \leq 200$,

> "the toner having an appropriate circularity, without causing the embedding of the fluidity-imparting agent to the toner particles, can be effectively produced" (p. 20, last four lines).

In Example 1 of the specification, a described toner was prepared, with the step of mixing the fluidity-imparting agent with the classified toner preparation material performed under the condition $(V \bullet T)/M = 100$ (p. 56, line 9), while in Comparative Example 1, the same ingredients, otherwise identically prepared, were mixed under the condition $(V \bullet T)/M = 225$ (p. 68, line 15), and in Comparative Example 2, the same ingredients, otherwise identically prepared, were mixed under the condition $(V \bullet T)/M = 40$ (p. 70, line 8). Results of image formation with these three toners, set forth in Table 1 on pp. 82-83, demonstrate clearly that superior image formation characteristics were obtained with the Example 1 toner prepared under the condition $50 \leq (V \bullet T)/M \leq 200$, as compared with the Comparative Example 1 and 2 toners respectively prepared under conditions above and below this inequality but otherwise the same as the Example 1 toner.

Thus, applicants' specification discloses and shows that the condition "$50 \leq (V \bullet T)/M \leq 200$" (in the fluidity agent - toner preparation material mixing step) results in product properties having a beneficial effect on the quality of image formation with the toner, and as such, is a proper product-by-process limitation entitled to weight in determining the patentability of the toner defined in claims 1 - 8, and the container-toner combination defined in claims 26 - 33, as herein amended.

Claims 1 and 26, and various dependent claims, have been rejected under 35 U.S.C. §102(e) or §103(a) as anticipated by or unpatentable over (obvious from) Karaki et al. All the claims now in the application have been rejected under §103(a) as unpatentable over Karaki et al. in view of Inaba et al. and the Diamond *Handbook*. Claims 1 - 8 have also been rejected under §103(a) as unpatentable over Ota in view of Inaba et al. and the Diamond *Handbook*. None of these references is even asserted to disclose the condition "$50 \leq (V \bullet T)/M \leq 200$" (in a fluidity agent - toner preparation material mixing step) or to suggest the beneficial effect of this limitation on properties of the toners thereby obtained. Therefore, applicants submit, the recital of the limitation "$50 \leq (V \bullet T)/M \leq 200$" added to claims 1 and 26 by the present Amendment defines a new toner product, not obvious from the prior art, affording unexpected results in improving image formation characteristics. It follows that the aforesaid limitation distinguishes all the claims now in the application patentably over the applied references and any proper combinations thereof.

For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

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